Office - Supreme Court, U. S.
FILED
MAR 25 1941
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1940.

No. 823.

JAX ICE & COLD STORAGE COMPANY, a corporation, trading as Jax Brewing Company, *Petitioner,*

v.

CONWAY P. COE, UNITED STATES COMMISSIONER OF PATENTS, and JACKSON BREWING COMPANY, a corporation, *Respondent.*

On Petition for a Writ of Certiorari to the United States Court of Appeals for the District of Columbia.

BRIEF FOR THE RESPONDENT, JACKSON BREWING COMPANY.

HERBERT H. PORTER.
Washington Loan & Trust Bldg.,
Washington, D. C.

ROBERT F. WHITEHEAD.
Munsey Building,
Washington, D. C.

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

INDEX TO BRIEF.

	Page
Opinions Below	1
Jurisdiction	2
Questions Presented	2
Statutes Involved	2
Statement	2
Contentions of Petitioner	4
Argument	5
Section 72a, Title 35, U. S. Code	8
Conclusion	9

INDEX TO APPENDIX.

Section 4915 R. S. (U. S. Code, Title 35, Sec. 63)	10
Section 9, Trade-Mark Act of 1905 (U. S. Code, Title 15, Sec. 89)	10
Section 72a, Title 35, U. S. Code	11

CASES CITED.

Arbetter Felling Machine Co. v. Lewis Blind Stitch Machine Co., 230 Fed. 992	6
Armstrong v. DeForest, 37 F. (2d) 438	6
Century Distilling Company v. Continental Distilling Corporation, 106 F. (2d) 486	8
Cleveland Trust Company v. Berry, 99 F. (2d) 517	4, 7
Coe v. Hobart Manufacturing Company, 70 App. D. C. 2, 102 F. (2d) 270	3, 8
Drackett v. Chamberlain, 81 F. (2d) 866	4, 7
Eno v. Coe, 70 App. D. C. 337, 106 F. (2d) 858	4
Hazeltine Corporation v. White, 68 F. (2d) 715	6
Pacific Steamboat Co. v. Peterson, 278 U. S. 130	6, 7
U. S. ex rel. The Baldwin Company v. Robertson et al., 265 U. S. 168	4, 5, 7

STATUTES CITED.

Section 4915, R. S. (Title 35, U. S. Code, Sec. 63)	2
Section 9, Trade-Mark Act of 1905 (Title 15, U. S. Code, Sec. 89)	2
Section 72a, Title 35, U. S. Code	2

IN THE

Supreme Court of the United States

OCTOBER TERM, 1940.

No. 823.

JAX ICE & COLD STORAGE COMPANY, a corporation, trading as Jax Brewing Company, *Petitioner,*

v.

CONWAY P. COE, UNITED STATES COMMISSIONER OF PATENTS, and JACKSON BREWING COMPANY, a corporation, *Respondent.*

On Petition for a Writ of Certiorari to the United States Court of Appeals for the District of Columbia.

BRIEF FOR THE RESPONDENT, JACKSON BREWING COMPANY.

Opinions Below.

The orders dismissing the complaint as to the Commissioner of Patents and also dismissing the complaint for lack of jurisdiction appear at pages 16 and 17 of the record.

The decision of the United States Court of Appeals for the District of Columbia appears at page 22 of the record.

Jurisdiction.

Jurisdiction of this court is invoked under Section 240(a) of the Judicial Code as amended by the Act of February 15, 1925 (U. S. Code, Title 28, Section 347).

Questions Presented.

The sole question presented in this case is whether the courts of the District of Columbia have jurisdiction in a suit brought under Section 4915 R. S. to effect the cancellation of a trade-mark registration where the named defendants are the Commissioner of Patents and the owner of the trade-mark registration, and the latter is not an inhabitant of the District of Columbia and has not consented to be sued therein.

Statutes Involved.

The applicable portions of the statutes involved, namely Section 4915 R. S. (U. S. Code Title 35, Section 63),* Section 72a, Title 35 U. S. Code, and Section 9 of the Trade Mark Act of February 20, 1905, (U. S. Code Title 15, Section 89) are set forth in the Appendix *infra*, pp. 10, 11.

Statement.

Petitioner filed in the United States Patent Office applications for the cancellation of two trade-mark registrations issued to respondent, Jackson Brewing Company (R. 5). These applications for cancellation were dismissed by the Examiner of Interferences and his decision was affirmed by the Commissioner of Patents (R. 6). The present complaint naming as defendants the Commissioner of Patents and the Jackson Brewing Company was filed August 3, 1939

*Section 4915 R. S. was amended by the Act of August 5, 1939 to be effective two months after the approval of the Act. This approval was subsequent to the filing of the complaint herein and these proceedings are under the statute as it existed prior to that amendment (see Section 5 of the Act).

(R. 1). Petitioner prayed that process issue under the provision of Section 72a, Title 35 of U. S. Code, directed to defendant, Jackson Brewing Company. As appears from the complaint, Jackson Brewing Company is a corporation organized and existing under the laws of Louisiana. It is not an inhabitant of the District of Columbia and has not consented (Special Motion, R. 11) to be sued in the courts of the District of Columbia.

Motions were filed in the District Court by each of the respondents, the Jackson Brewing Company moving to dismiss the complaint on the ground of lack of jurisdiction, and the Commissioner of Patents moving to dismiss the complaint as to him (R. pp. 11 and 12). Both motions were granted by the District Court (R. pp. 17 and 16). Thereafter petitioner took an appeal to the United States Court of Appeals for the District of Columbia. On December 9, 1940 that Court affirmed the judgment of the District Court, stating, in a *per curiam* opinion (R. 22):

> "This case is governed by Coe v. Hobart Manufacturing Company, 70 App. D. C. 2, 102 F. (2d) 270, and J. C. Eno (U. S.) Limited v. Coe, 70 App. D. C. 337, 106 F. (2d) 858. We have carefully considered the earnest and thoughtful argument of appellant's counsel that we should overrule those cases, but we are still of opinion that they were rightly decided. The judgment appealed from is therefore affirmed."

In *Coe* v. *Hobart Manufacturing Company*, 70 App. D. C. 2, 102 F. (2d) 270, the complaint was filed by the unsuccessful party to a patent interference, against the Commissioner of Patents and the successful party, alleging jurisdiction under Section 72a, Title 35 U. S. Code. The Court of Appeals for the District of Columbia directed the dismissal of that suit on the ground that Section 72a, Title 35 U. S. Code is limited to a case where there are adverse parties residing in different Districts not embraced within a single state, and that the Commissioner of Patents was not a party adverse to the plaintiff and therefore the Dis-

trict Court of the United States for the District of Columbia did not have jurisdiction of the suit.

In *Eno* v. *Coe*, 70 App. D. C. 337, 106 F. (2d) 858, the suit was brought by the unsuccessful party in a trade-mark opposition proceeding in the Patent Office against the successful party and the Commissioner of Patents. The registration was granted and the Bill was amended to seek cancellation of that registration. The successful party in the Patent Office was not an inhabitant of the District of Columbia and on motion the bill was dismissed as to him. When the case reached the Court of Appeals for the District of Columbia, that Court held that the bill should have been dismissed for the lack of a necessary party, stating that the validity of a trade-mark registration could not be litigated in a suit to which the owner of the registration was not a party, and that this was elementary and an obvious matter of due proceses.

Contentions of Petitioner.

Petitioner urges in its brief three reasons for the granting of the writ of certiorari:

I. That there is a conflict between the decision of the Court of Appeals and the decision of this Court in *U. S. ex rel. the Baldwin Company* v. *Robertson et al.*, 265 U. S. 168.

II. That the decision of the Court of Appeals in this case is in conflict with the decision of the Circuit Court of Appeals of the Sixth Circuit in the case of *Cleveland Trust Company* v. *Berry*, 99 F. (2d) 517, and with the decision of the Circuit Court of Appeals of the Third Circuit in the case of *Drackett Company* v. *Chamberlain Company*, 81 F. (2d) 866.

III. That the questions decided by the Court of Appeals are of grave importance to the public generally and particularly the industrial public.

Argument.

I. There is no conflict between the decision herein of the Court of Appeals for the District of Columbia and the decision of this Court in *U. S. ex rel. The Baldwin Company* v. *Robertson et al. supra.*

As appears from the decision of this Court, a suit against the Commissioner of Patents had been brought in the Supreme Court of the District of Columbia (now the District Court of the United States for the District of Columbia) to enjoin him from cancelling two registrations in accordance with the decision of the Court of Appeals of the District of Columbia on direct appeal from the Patent Office and the successful party in the cancellation proceeding had intervened. The Court of Appeals reversed the decision of the lower Court and dismissed the bill on the ground that Section 4915 R. S. relates to patents alone and is not applicable to trade-mark cases.

This ground constituted the question which was before this Court on the appeal. There was no question involved as to the Commissioner of Patents being a proper party or as to the right of the plaintiff to bring the suit against the Commissioner of Patents alone since, due to the intervention, both of the interested parties were before this Court.

In its decision this Court with reference to the construction to be given Section 9 of the Trade Mark Act said:

> "We have, in the cases cited, given the closing words of Section 9 a liberal construction in the view that Congress intended by them to give every remedy in respect to trade-marks which is afforded in proceedings as to patents."

The Court further said:

> "It is not an undue extension of that construction to hold that the final words were intended to furnish a remedy in equity against the Commissioner in every case in which by Section 9 appeal lies first to the Court of Appeals."

It i therefore clear that the Court ruled that the rights accorded to trade-mark applicants are the same as those accorded to patent applicants by the provisions of Section 4915 R. S. and that ruling was the basis of the decision.

The cases in which Section 4915 R. S. can be invoked were two-fold. First, the cases in which a patent had been refused on *ex parte* application, and second, cases where a decision had been rendered in an interference against an applicant involved therein. It had never been held by any court that the losing party to an interference could bring a suit under Section 4915 R. S. to review the decision of the Patent Office except as against the winning party and by bringing that suit in the district of which the latter is an inhabitant. (*Arbetter Felling Machine Co.* v. *Lewis Blind Stitch Machine Co.*, 230 Fed. 992; *Armstrong* v. *DeForest*, 37 F. (2d) 438, and *Hazeltine Corporation* v. *White*, 68 F. (2d) 715.)

If the decision of this Court can be construed to give trade-mark owners the right to bring a suit under Section 4915 R. S. naming the Commissioner of Patents alone as a defendant and bring that suit in the District of Columbia, in a case where there had been a contest in the Patent Office, then the trade-mark owners have not merely the same rights under Section 4915 R. S. that patent applicants have, as this Court expressly ruled, but greater rights.

This Court in the case of *Pacific Steamboat Co.* v. *Peterson*, 278 U. S. 130, pointed out that general statements made in a prior decision as to the construction of a statute where the particular point referred to was not involved in an earlier suit, are not controlling in determining the proper construction of the statute where the point is directly involved.

This Court in that decision, after noting the argument that the construction of the statute was controlled by the statements in the earlier decision, said:

> "This was at most a general expression respecting a particular as to which no question was raised * * * which ought not control the judgment in a subsequent

> suit when the very point is presented for decision * * * or to prevent the determination as an original question of the proper construction of the statute in that particular."

Neither the question of the right to sue the Commissioner of Patents alone nor the question of the Court in which the suit could be brought was involved in *U. S. ex rel. The Baldwin Company* v. *Robertson et al., supra,* and interpreting the decision in that case as required by the decision of this Court in *Pacific Steamboat Co.* v. *Peterson, supra,* there is no conflict between the decision of the Court of Appeals herein and the decision of the Court in the former case.

II. There is no conflict between the decision of the Court of Appeals for the District of Columbia in this case and the decision of the Circuit Court of Appeals of the Sixth Circuit in *Cleveland Trust Company* v. *Berry,* 99 F. (2d) 517. In that case, which was brought under the provisions of Section 4915 R. S. by the losing party to a patent interference in the Patent Office against the winning party, the Court stated that the Commissioner was a proper party and might have intervened, but the Court did not rule that the Commissioner was a necessary party, and, after overruling all of the objections to the validity of the suit, proceeded to determine the case on its merits.

It may be noted that the Court specifically stated that the decree which is entered in a suit under Section 4915 R. S.:

> "* * * has judicial force and immediately and definitely determines the rights of the parties. It becomes the decision of the Patent Office and is to govern the action of the Commissioner."

Nor is there any conflict between the decision in this case and the decisions of the Third Circuit. In *Drackett* v. *Chamberlain,* 81 F. (2d) 866, the Court of Appeals of the Third Circuit stated that the case was properly dismissed because the Commissioner was a necessary party and was

not present, basing that ruling on the ground that there had been no decision between the two parties in the Patent Office since registration of the mark had been refused merely on the ground that it was descriptive and its registration therefore barred by the specific provisions of the Trade Mark Act. No such situation exists in the present case. Furthermore in the later decision of the same Court in *Century Distilling Company* v. *Continental Distilling Corporation,* 106 F. (2d) 486 where, as in the present case, a decision was rendered between the two parties in the Patent Office, the same Court held that the Commissioner of Patents was not a necessary party to the suit under Section 4915 R. S. and stated that the District Court had erred in dismissing the bill on that score.

III. The question decided herein by the Court of Appeals for the District of Columbia is not one of general importance. It does not in any way relate to the right of the losing party in a contested trade-mark proceeding in the Patent Office to bring a suit against the winning party in the Patent Office under the provision of Section 4915 R. S. It relates merely to the Court in which the suit may be brought. Unquestionably the suit could have been brought in the District of which Jackson Brewing Company is an inhabitant.

Section 72a, Title 35 U. S. Code.

The decision in *Hobart Manufacturing Company* v. *Coe, supra,* on which the decision in the present proceeding is in part based merely follows the language of the above statute since the Commissioner of Patents cannot have an interest adverse to any party in a contested proceeding in the Patent Office and therefore cannot be an adverse party within the meaning of that term as used in Section 72a Title 35 U. S. Code.

Conclusion.

There is no conflict of decisions and no question of general importance has been determined. It is submitted therefore that the petition for writ of certiorari should be denied.

Respectfully submitted,

HERBERT H. PORTER.
Washington Loan & Trust Bldg.,
Washington, D. C.

ROBERT F. WHITEHEAD.
Munsey Building,
Washington, D. C.